

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHRISTINE A. RICH

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Appeal No. 1998-2383  
Application No. 08/116,355

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ON BRIEF

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Before COHEN, NASE, and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 17, 19, 22, 28-30, 32-48, 50, 51 and 56-58. Claims 49 and 24-26 stand allowed and claims 52-55 and 59 stand withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention. No other claims remain pending in this application.

### BACKGROUND

The appellant's invention relates to methods of exercising a number of different muscles or muscle groups of the body using at least one resilient stretchable element. An understanding of the invention can be derived from a reading of independent claims 17, 35, 41, 46, 47, 50 and 51, which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Chellis et al. (Chellis)	735,065	Aug. 4, 1903
Richardson	3,677,543	Jul. 18, 1972
Holappa	4,198,044	Apr. 15, 1980
Goodman	4,304,401	Dec. 8, 1981
Piccini	4,325,548	Apr. 20, 1982
Tee	4,909,505	Mar. 20, 1990
British reference	GB 015797	Aug. 1893 <sup>1</sup>

Additionally, the following prior art references are made of record by this panel in remanding the application to the examiner:<sup>2</sup>

Colonello	4,752,067	Jun. 21, 1988
Suarez et al. (Suarez)	4,815,731	Mar. 28, 1989

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<sup>1</sup> The only portion of this reference contained in the application file is a single drawing labeled "FIG. III" and it is from this drawing alone that we derive our understanding of the teachings of the reference.

<sup>2</sup> Copies of these references are appended to this decision.

The following rejections are before us for review.<sup>3</sup>

1. Claims 51, 32-34 and 58 stand rejected under 35 U.S.C. § 103 as being unpatentable over Holappa in view of Chellis, Richardson and Goodman.
2. Claims 35, 39-42, 46-48, 56 and 57 stand rejected under 35 U.S.C. § 103 as being unpatentable over Holappa in view of Chellis, Tee and Richardson.
3. Claim 50 stands rejected under 35 U.S.C. § 103 as being unpatentable over Holappa in view of Chellis and Richardson.
4. Claims 17, 19, 36, 50 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Holappa in view of Chellis, Tee, Richardson and the British reference.
5. Claims 22, 29 and 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Holappa in view of Chellis, Tee, Richardson, the British reference and Piccini.<sup>4</sup>
6. Claims 38 and 45 stand rejected under 35 U.S.C. § 103 as being unpatentable over Holappa in view of Chellis, Tee, Richardson and Piccini.

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<sup>3</sup> As evident from the requests for clarification in the appellant's brief (Paper No. 20), first reply brief (Paper No. 23) and second reply brief (Paper No. 25, page 2), the examiner's Office action (Paper No. 17, mailed February 11, 1997) and answer (Paper No. 21, mailed December 2, 1997) contain errors in the statements of the rejections which have been clarified by the examiner's supplemental communication (Paper No. 24, mailed April 29, 1998). The appellant has not alleged that these clarifications constitute new grounds of rejection. We have considered the examiner's supplemental communication mailed after the appellant's first reply brief and the appellant's second reply brief only to the extent necessary to understand what rejections are before us. We have not considered any arguments presented in these papers with regard to the merits of these rejections, since 37 CFR § 1.193 provides for neither supplemental examiner's answers, except upon remand from the Board of Patent Appeals and Interferences for such purpose, nor supplemental reply briefs.

<sup>4</sup> It is apparent from the examiner's remarks on page 4 of the answer, read in light of item 2 (apparent errors in last Office action) on page 10 of the appellant's brief, that the omission of Tee in this rejection was an inadvertent error. In any event, the appellant is not prejudiced by this interpretation in view of: (1) our treatment of this rejection, infra, and (2) the appellant's assumption (brief, page 10) that Tee is included in the rejection.

7. Claim 43 stands rejected under 35 U.S.C. § 103 as being unpatentable over Holappa in view of Chellis, Tee, Richardson and the British reference.

8. Claim 44 stands rejected under 35 U.S.C. § 103 as being unpatentable over Holappa in view of Chellis, Tee, Richardson, the British reference and Piccini.

9. Claim 30 stands rejected under 35 U.S.C. § 103 as being unpatentable over Holappa in view of Chellis, Richardson and Piccini.

Reference is made to the brief and first reply brief (Papers No. 20 and 23) and the answer (Paper No. 21) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See

In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

As discussed more fully below, we conclude that the examiner has failed to supply the requisite factual basis for the determination that the methods of independent claims 17, 41, 46, 47, 50 and 51, and the claims depending therefrom, would have been obvious to one of ordinary skill in the art at the time of the appellant's invention.

Claim 17 requires, inter alia, the steps of:

extending the leg to which the resilient stretchable element is attached to substantially full length to stretch and elongate the element;

swinging the extended leg and the extended element from a first position in which the leg extends upwardly in the vertical and is closely adjacent a plane bisecting the head and hips of the person exercising to a second position

outwardly and away from the vertical and the last mentioned plane, and back to said first position.

The method of claim 41 includes the step of "assuming a lying position on the person's side with one leg extended adjacent the surface upon which the person is lying." Claim 46 requires, inter alia, the step of "simultaneously moving the hips upwardly against the elongate stretchable element." Claim 47 recites a method comprising, inter alia, the step of "assuming a sitting position with the knees bent and spaced outwardly from each other and the feet together." The method of claim 51 includes the step of moving the leg to which the elongated element is attached "from a first position in which the leg is closely adjacent a plane bisecting the head and hips . . . to a second position outwardly and away from the last mentioned plane."

Claim 50 requires, inter alia, the steps of:

extending the leg to which the resilient stretchable element is attached to substantially full length to stretch and elongate the element;

swinging the extended leg and the extended element from a first position in which the leg is closely adjacent a plane bisecting the head and hips of the person exercising to a second position outwardly and away from the last mentioned plane; and

wherein the person exercising is lying on the person's side with the extended leg having a pair of resilient stretchable elements attached thereto . . . and said extended leg is swung backward at the knee from said first position to said second position while bending the knee and back to said first position.

Quite simply, we have reviewed the combined teachings of all of the prior art references (i.e., Holappa, Chellis, Tee, Richardson, Goodman, Piccini and the British reference) applied by the examiner in rejecting these claims and we find no teaching or suggestion therein of the above-noted steps of independent claims 17, 41, 46, 47, 50 and 51.

With regard to the particular body positions and movement of body parts recited in the claims, the examiner contends that

once a resilient member is attached to a stationary object and then to a body limb which is to be manipulated against the resistance of the resilient member, it would have been obvious to one of ordinary skill in the art to move that body part in any one of the infinite directions in which that body part/limb is capable of moving to thereby strengthen the limb in its totality. The examiner is of the opinion that the claimed methods of use are included within the segment of the infinite number of direction/movements which are obvious to one of ordinary skill in the art [answer, page 6].

The examiner, however, has adduced no evidence to support the assertion that the particular above-mentioned body positions and movements recited in independent claims 17, 41, 46, 47, 50 and 51 would have been known to one of ordinary skill in the exercising art at the time of the appellant's invention as part of an exercise routine generally, much less as part of an exercise routine using at least one resilient stretchable element. Thus, it appears to us that the examiner's rejections of these claims stem from impermissible speculation, unfounded assumptions or hindsight reconstruction.

Further, the examiner's assertion (answer, page 6) that "[i]f the board agrees that the apparatus which is provided to perform the above claimed method is obvious," then "the

method of using the device is obvious in view of the combined teaching of the methods presented, directed to the use of using the device singularly and in combination." While Holappa discloses an exercise board for use in attaching flexible stretchable elastic belts and various methods of exercising body muscles by movement of body parts against the resistance of the belts, Chellis discloses tension members for attachment to either the hand or foot for exercising the arms or legs, and Richardson, Goodman, Piccini, Tee and the British patent disclose various exercises to be performed using resilient elastic resistance members, none of these references, either alone or in combination with the other references, teaches or suggests the particular above-noted body movements recited in independent claims 17, 41, 46, 47, 50 and 51. We do not share the examiner's apparent opinion that the disclosure of one method of exercising a body part necessarily renders obvious every other method of exercising that body part.

Accordingly, we shall not sustain the examiner's rejections of independent claims 17, 41, 46, 47, 50 and 51, or of claims 19, 22, 28-30, 32-34, 42-45, 48, 57 and 58 which depend therefrom.

With regard to independent claim 35, which the examiner has rejected based upon the combined teachings of Holappa, Chellis, Tee and Richardson, we note that Tee (Figure 4E and column 7, lines 48-53) discloses a method of exercising wherein the exerciser assumes a kneeling position on one knee, with a resilient stretchable element (elastomeric loop 14)



attached stationarily at one end, at a door stop (52) or to a permanent wall bracket (column 5, lines 37-40), and attached at the other end, by means of a foot strap (79), to the foot of the leg which is not kneeling. The exerciser takes a sprinter start position with the leg extended behind and slowly pulls the leg forward, away from the knee of the kneeling leg, to stretch and elongate the element. The exerciser then slowly returns the moving leg to the starting position. This movement also moves the foot of the moving leg toward and away from the foot of the kneeling leg. While Tee explicitly discloses that the exercise illustrated in Figure 4E exercises the thigh, it is apparent to us that such movement of the leg necessarily also exercises the gluteal muscles of the exerciser. Thus, we conclude that Tee anticipates<sup>5</sup> the method of claim 35. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Accordingly, we shall sustain the examiner's rejection of claim 35, and claims 36-38 which stand or fall with claim 35 (brief, page 8).

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<sup>5</sup> Anticipation is established when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). Under the principles of inherency, if the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)

With regard to claims 39 and 40, which depend from claim 35, however, we find no teaching or suggestion in any of the references applied by the examiner in rejecting these claims to attach the stationary end of the resilient stretchable element either adjacent the knee of the kneeling leg (claim 39) or to the foot of the kneeling leg (claim 40). As to claim 56, which also depends from independent claim 35, the additional steps of extending the moving leg to substantially full length and arcuately swinging the foot of the extended leg are not taught or suggested by Tee or the other applied references, Holappa, Chellis and Richardson, either alone or in combination. Accordingly, we shall not sustain the examiner's rejection of claims 39, 40 and 56.

#### REMAND TO THE EXAMINER

We remand the application to the examiner for consideration of the following issues:

1. With regard to claim 41, and all claims depending therefrom, we note that U.S. Patent No. 4, 815,731, issued to Suarez et al. (Suarez) on March 28, 1989, discloses, in Figure 1, a method wherein the cuffs (3) of an exercise device, also comprising an intervening coil spring (4) and elastic cord (5), are placed around the ankles of a user. The user moves the limbs away from each other to cause the spring (4) to stretch, thereby providing resistance to the outward movement of the limbs (column 3, lines 31-36). Further, it appears to us that the user illustrated in Figure 1 is lying on her side. The method of Suarez differs from the method of claim 41 in that the cuffs are not attached to the foot of the user. The application is remanded

to the examiner to consider whether it would have been obvious, either in view of the teachings of Suarez alone or in combination with other prior art of which the examiner may be aware, to attach the cuffs of the exercise device to the feet, rather than the ankles of the user, in carrying out the Suarez method.

2. With regard to claim 46, Holappa teaches the use of the disclosed exercise board for exercising the abdominal muscles by lifting and lowering the legs and, optionally, doing a partial sit-up exercise while the legs are retained on the exercise board (column 2, line 66, to column 3, line 4). While Holappa does not disclose the step of "simultaneously moving the hips upwardly against the elongate stretchable element" as required by claim 46, U.S. Patent No. 4,752,067, issued to Colonello on June 21, 1988, suggests that a maneuver called a "pelvic tilt" consisting of flexing the pelvis to flatten the lower back and thereby reduce strain on the sensitive discal structures, in the context of sit-ups, would have been familiar to "the exercise enthusiast" at the time of the appellant's invention (column 5, lines 14-18). The examiner may, in fact, be aware of other references which teach that such a maneuver would have been well known to one of ordinary skill in the exercising art at the time of the appellant's invention. The application is remanded to the examiner to consider whether it would have been obvious, in view of, for example, the combined teachings of Holappa and Colonello and/or other prior art, to simultaneously move the hips upwardly, as in a pelvic tilt maneuver, against resistance provided by a resilient element overlying the person's hips as required by claim 46.

### CONCLUSION

To summarize, the decision of the examiner to reject claims 17, 19, 22, 28-30, 32-48, 50, 51 and 56-58 under 35 U.S.C. § 103 is affirmed as to claims 35-38 and reversed as to claims 17, 19, 22, 28-30, 32-34, 39-48, 50, 51 and 56-58. Additionally, the application is remanded to the examiner for consideration of the patentability of at least claims 41 and 46 in light of the above discussion.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART AND REMANDED

IRWIN CHARLES COHEN  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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